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In re application of Gary Dejong et al.
Serial No. : 09/815,981 : DECISION ON PETITION
Filed : March 22, 2001
Attorney Docket No.: 24601-416B

This is in response to applicant's petition, filed November 18, 2003 under 37 CFR 1.181, to withdraw the finality of the Office action mailed September 30, 2003.

BACKGROUND

Review of the file history shows that the application was filed March 22, 2001 under 35 U.S.C. 111(a). On December 16, 2002 the examiner mailed a first Office action on the merits, wherein claims 1-16 and 30 were rejected. Applicants filed a response, including amendments to the claims, on June 16, 2003. On September 30, 2003 the examiner mailed an Office action which included new grounds of rejection for claims 4, 14 and 15. The examiner made the action final, stating that the new grounds of rejection were not previously rejected because of a typographical error.

DISCUSSION

The claims at issue are claims 4, 14 and 15, which all depend on claim 1. In the first Office action, claims 1, 4, 14 and 15 were rejected under 35 U.S.C. 102(b) over each of Felgner et al., Neves et al. and Zelphati et al. Claims 1-3 and 11-13 were rejected under 35 U.S.C. 103 over either one of Felgner et al. or Zelphati et al.; taken in view of Nolan et al. In the rejection, the examiner stated, "Felgner et al. and Zelphati et al. teach all of the limitations of the method according to claim 1. Felgner et al. and Zelphati et al. do not, however, teach the method wherein the transferred DNA is a large DNA or chromosome." In the response filed June 16, 2003 claim 1 was amended to read, "introducing labelled large nucleic acid molecules." In the final Office action, the rejections under 35 U.S.C. 102(b) were withdrawn and claims 4, 14 and 15 were added to the rejection under 35 U.S.C. 103. These changes were clearly necessitated by applicants' amendment which overcame the rejections under 35 U.S.C. 102(b).

Applicants argue that claims 4, 14 and 15 have not been amended. This argument is not persuasive. As stated in 37 CFR 1.75(c), "Claims in dependent form shall be construed

to include all the limitations of the claim incorporated by reference into the dependent claim." Thus the amendment to claim 1 effectively amended claims 4, 14 and 15, as well.

Applicants argue that the rejection of claims 4, 14 and 15 could have been advanced in the previous Office action. This argument is not persuasive. While the rejection *could* have been made, examiners are admonished not to cite unnecessary references. MPEP 904.03 states, in part:

> In selecting the references to be cited, the examiner should carefully compare the references with one another and with the applicant's disclosure to avoid the citation of an unnecessary number. The examiner is not called upon to cite all references that may be available, but only the "best."

Since three different 102(b) references (statutory bars) were cited in the first action, there was no reason to add an additional obviousness rejection including the Nolan reference. Once the claims were amended, the new ground of rejection became necessary.

It is unfortunate that the examiner indicated that a typographical error had been made, since this does not appear to have been the case at all. It does not appear that any error was made in rejecting the claims in either Office action.

DECISION

Applicant's petition is **DENIED**.

Any request for reconsideration or review of this decision must be made by a renewed petition and must be filed within TWO MONTHS of the mailing date of this decision in order to be considered timely.

Should there be any questions with regard to this letter please contact Bruce Campell by letter addressed to the Director, Technology Center 1600, P.O. Box 1450, Alexandria, VA, 22313-1450, or by telephone at (571) 272-0974 or by facsimile transmission at (571) 273-0974.

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